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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/601,812

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Bruce Daniel MacMillan

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AT&T Legal Department - WK

Attn: Patent Docketing

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EXAMINER

DANG, THANH HA T

ART UNIT

PAPER NUMBER

2163

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02/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/601,812	<b>Applicant(s)</b> MACMILLAN, BRUCE DANIEL	
	<b>Examiner</b> Thanh-Ha Dang	<b>Art Unit</b> 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,8-13,15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) 4-7,14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-13,15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-3, 8-13, 15 and 17-21 are rejected in this Office Action.
2. Applicant cancelled Claims 4-7, 14 and 16.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/06/08 has been entered.

### ***Response to Amendment***

4. Receipt of Applicant's Amendment filed 12/06/08 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 8-13, 15, 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 7,127,491 issued to Robert Charles Zirnstein, Jr. ("Zirnstein").

As to **Claims 1, 17 and 20**, *Zirnstein teaches* a method for retrieving information in a private database, the method comprising:

- receiving at an e-mail server, via an e-mail, a request from a wireless communication device to retrieve the information in the private database (*Figures 1 and 4-5, column 2, lines 23-38; column 4, lines 43-48; and column 5, lines 1-9*);
- upon receiving the request, the e-mail server comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server (*Figure 11*), and if the identified e-mail address is on the list, the e-mail server retrieving the information from the private database (*Figures 11-12, column 12, lines 48-67; and column 14, lines 12-48*).
- sending, at the e-mail server, the information retrieved by the e-mail server to the wireless communication device (*Figures 12 and 14A-B, column 16, lines 2-45*); and
- denying the request to retrieve the information when the identified e-mail address is not on the list (*Figure 12 blockS1211, column 14, lines 30-40*).

As to **Claim 2**, *Zirnstein teaches* wherein receiving the request includes receiving the e-mail from the wireless communication device (*Figure 1, column 2, lines 23-38; column 4, lines 43-48; and column 5, lines 1-9*).

As to **Claim 3**, *Zirnstein teaches* wherein receiving the e-mail from the wireless communication device includes receiving the e-mail from one of a wireless telephone, a wireless pager and a wireless personal digital assistant (*column 2, lines 5-6*).

As to **Claim 8**, *Zirnstein teaches* wherein the request to retrieve information includes identifying text in the e-mail (*column 9, lines 3-12*).

As to **Claim 9**, *Zirnstein teaches* wherein identifying text in the e-mail includes identifying a word associated with the information (*Figure 7, column 10, lines 34-50 wherein the illustration of the command word 'help' read on the word associated with the information limitation*).

As to **Claim 10**, *Zirnstein teaches* wherein identifying the word in the e-mail includes identifying an acronym associated with the information (*Figure 10, column 12, lines 12-25 wherein CMD, TXT, URL, HTML read on acronym claimed limitation*).

As to **Claim 11**, *Zirnstein teaches* wherein identifying text in the e-mail includes identifying a phrase associated with the information (*Figure 10, column 12, lines 8-47*).

As to **Claims 12 and 13**, *Zirnstein teaches* wherein identifying text in the e-mail includes identifying a letter and a number associated with the information (*Figures 7-10, column 10, lines 51-67*).

As to **Claim 15**, *Zirnstein teaches* wherein sending the information to the wireless communication device includes sending an outbound e-mail to the wireless communication device (*Figure 1, column 10, lines 55-67*).

***Claim Rejections - 35 USC§ 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 7,127,491 issued to Robert Charles Zirnstein, Jr. ("Zirnstein") as applied to Claim 17, and further in view of Pub. No. US2003/0130857 issued to Matsuo ("Matsuo").

As to **Claim 18**:

*Zirnstein teaches* all the elements of Claim 17 as stated above.

*Zirnstein does not explicitly teach* wherein the e-mail server comprises a portion of an Intranet.

*Matsuo teaches* wherein the e-mail server comprises a portion of an Intranet (*page 10 [0114, line 4]*). Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine method for utilizing an information exchange framework teaching of Matsuo with remote command

server teaching of Zirnstein to provide method and system which include an Intranet.

**As to Claim 19:**

*Zirnstein teaches* all the elements of Claim 17 as stated above.

*Zirnstein does not explicitly teach* wherein the e-mail server comprises a portion of an Extranet.

*Matsuo teaches* wherein the e-mail server comprises a portion of an Extranet (*page 10 [0114, line 5]*). Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine method for utilizing an information exchange framework teaching of Matsuo with remote command server teaching of Zirnstein to provide method and system which include an Extranet.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 7,127,491 issued to Robert Charles Zirnstein, Jr. ("Zirnstein") as applied to Claim 17, and further in view of US Patent No. 6,029,192 issued to Hill et al. ("Hill").

**As to Claim 21:**

*Zirnstein teaches* all the elements of Claim 17 as stated above.

*Zirnstein does not explicitly teach* wherein the information comprises a list of documents which are listed by order of relevance.

*Hill teaches* wherein the information comprises a list of documents which are listed by order of relevance (*Figure 14 block1402, column 11, line 15*). Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine resource evaluation derived from electronic messages teaching of Hill with remote command server teaching of Zirnshtein to provide method and system which display information by order of relevance.

### ***Response to Applicant Arguments***

7. Applicant's amendment and arguments filed 12/06/08 with respect to claims 1-3, 8-13, 15 and 17-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Citation of Pertinent Prior Art***

8. The prior art made of record and not relied upon in form PTO-892 if any is considered pertinent to applicant's disclosure.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH-HA DANG whose telephone number is (571)272-4033. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-



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1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thanh-Ha Dang  
Examiner, AU 2163  
January 23, 2009

/don wong/  
Supervisory Patent Examiner, Art Unit 2163